

E³
Cont.

decreasing friction optionally contains a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

Please add the following claim.

E⁴

44. (New) The composition of any one of 30-34 and 39-43 wherein said composition is substantially anhydrous.

REMARKS

Appellant submits this amendment pursuant to 37 C.F.R. §1.116 in response to the May 22, 2002 Examiner's Answer rejecting claims 29 and 42 as "obvious" (May 22, Examiner's Answer, sentence bridging pages 4 and 5 and citation of Ex parte Obiaya, 227 U.S.P.Q. 58, 60(Bd. Pat. App. & Int. 1985)), further noting "claims 29, 35 and 42 are anticipated by the teachings of Admitted Prior Art, Levy 4, 985,251 combined with Brannon-Pappas [sic, Peppas]." (May 22 Examiner's Answer at page 5 first full paragraph) (emphasis added).

The Examiner goes further by stating "[I]n response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking the references individually where the rejections are based on a combination of references. . . .It appears that applicants [sic] have failed to appreciate that the rejection is based on combinations of references" (May 22 Examiner's Answer at page 5 second and third paragraphs) (citations omitted) (emphasis added).

The Examiner initially rejected these claims under 35 U.S.C. § 102(b), and by using the term "anticipation" in the May 22 rejection, correctly referred to the 35 U.S.C.

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§102(b) rejection. Combining references, however, precludes the use of 35 U.S.C. §102(b) in rejecting the claims, and furthermore the Examiner specifying the rejection of these claims as "obvious," arguing the appellant "cannot show nonobviousness by attacking the references individually," and claiming "the rejection is based on combinations of references" further confirms the Examiner's intent to make the rejection of claims 29, 35 and 42 under 35 U.S.C. §103 an obviousness rejection.

Appellant has no recourse except to respond to the Examiner's Answer as rejecting the claims on a new ground of rejection by finding them "obvious." This amendment after final rejection responds to the new ground of rejection.

The Amendments

The amendment to claim 29 defines the synthetic oil lubricant as a polymerized olefin, organic ester lubricant, polyglycols, organic phosphates, silicones, polyphenyl ethers, silicates, chlorinated aromatics and fluorocarbons. The paragraph bridging pages 9 and 10 of the written description supports this amendment.

The amendment to claim 29, further characterizes the material for decreasing friction as a petroleum oil lubricant or a two-mol ethoxylate of isostearyl alcohol. Pages 6 and 7 of the written description support the amendment of the claims to include petroleum oil lubricants and the first full paragraph on page 30 supports the amendment of the claims to indicate one of the synthetic lubricant compositions comprises a two-mol ethoxylate of isostearyl alcohol. This part of the amendment to claim 29 further notes that when the material for decreasing friction comprises a petroleum oil lubricant or a two-mol ethoxylate of isostearyl alcohol, the claimed lubricant composition

comprises a substantially anhydrous lubricant composition. The second paragraph on page 29 of the written description supports this amendment to the claims by describing a process for removing "substantially" all of the water from a superabsorbent polymer-lubricant composition swollen with water by placing this composition in a 27-38 % R.H. environment, or under vacuum, or at elevated temperatures.

The second paragraph on page 29 of the written description also supports new claim 44 relating to the substantially anhydrous compositions by describing a process for removing "substantially" all of the water from a superabsorbent polymer-lubricant composition swollen with water by placing this composition in a 27-38 % R.H environment, or under vacuum, or at elevated temperatures.

Appellant has introduced these amendments in order to distinguish the Brannon-Peppas and Levy references that the Examiner applied in rejecting claims 29, 35 and 42 as obvious.

The Examiner argues "Brannon-Peppas teach that their SAP [superabsorbent polymers] are well-known and commercially available as well as their chemical and physical properties including their ability to absorb greater than 100 times its weight in water, note page 245" (Examiner's Answer, page 6, lines 9-11) The Examiner then combines this teaching with the Levy reference's disclosure of insecticides and herbicides based on superabsorbent polymers, and concludes this teaches the lubricant compositions of claims 29, 35 and 42. The Examiner notes that Brannon-Peppas discloses superabsorbent polymers used with water, and then refers to appellant's discussion of water as a known lubricant.

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Appellant distinguishes this disclosure by claiming the lubricant additive as mandatory in the water-superabsorbent composition. The Examiner, however, has construed the claims on appeal as setting out the lubricant additive as "optional" in all instances. The claims, however include lubricant additives as an "optional" component only when the lubricant does not comprise water.

The Examiner applies the teachings of Brannon-Peppas to the Levy disclosure of an insecticide or herbicide compound in combination with a superabsorbent polymer and concludes "the secondary references [Brannon-Peppas] provide the teachings to substitute the polymers of the secondary references in the composition of the primary reference [Levy]. (Examiner's Answer, page 6, lines 12-13) This argument confirms that the Examiner has rejected claims 29, 35, and 42 under 35 U.S.C. § 103, since the Examiner has not used the complete teaching of Brannon-Peppas to reject the claims.

The Levy disclosure relates in part to an insecticide based on Arosurf ® MSF, a two-mol ethoxylate of isostearyl alcohol (Levy, Col. 17, lines 13-14), or a herbicide based on "petroleum derivatives" (Levy, col. 13, line 63), a superabsorbent polymer and water. The present amendment distinguishes the disclosures of Brannon-Peppas and Levy in that the former does not disclose Arosurf ® MSF or petroleum derivatives, and the latter does not disclose a substantially anhydrous combination of a superabsorbent polymer and Arosurf.® MSF or petroleum derivatives. Lastly, neither reference discloses a lubricant composition.

Appellant submits that with Brannon-Peppas teaching superabsorbent polymers and Levy teaching an insecticide composition that includes water in combination with a

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superabsorbent polymer and either petroleum derivatives or a two-mol ethoxylate of isostearyl alcohol, the claims as presently amended to cover, inter alia, compositions where these lubricant compositions are anhydrous, distinguish this disclosure of the references.

Appellant submits that that neither Brannon-Peppas nor Levy, or the combination of their teachings would inform a person with ordinary skill in the art that the superabsorbent polymer, after contact with water and combination with either petroleum lubricants or a two-mol ethoxylate of isostearyl alcohol would cause the polymer to become sufficiently porous to take up either of these lubricants, and further, upon the elimination of water, the lubricants would remain in the polymer structure.

The written description on pages 29 and 30 describe this mechanism, which neither Brannon-Peppas nor the Levy reference would teach or suggest to a person with ordinary skill in the art. Accordingly, the claims as amended distinguish Brannon-Peppas and Levy relative to petroleum derivatives or a two-mol ethoxylate of isostearyl alcohol in combination with a superabsorbent polymer

Appellant no longer relies on the previous distinctions of the present invention over the prior art description of superabsorbent polymers in combination with a two-mol ethoxylate of isostearyl alcohol.

The amendment to claim 32 corrects a typographical error, changing "organic" to --inorganic--, to properly characterize the solid lubricants such as molybdenum disulfide and the like. This amendment was not necessitated by the Examiner's Answer, but appellant submits it at this time as an expedient to prosecuting the application.

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Conclusions

Appellant requests that the Examiner enter the amendment for the foregoing reasons. If entry of this amendment requires an extension of time pursuant to 37 C.F.R. §1.136 or payment of an extension of time fee or other fee, any of which this amendment fails to account for, appellant's attorneys request such an extension and payment of any fees due from their Deposit Account 06-0916.

Respectfully submitted,

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By: 
Robert J. Eichelburg
Reg. No. 23,057

Dated: August 27, 2002

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ATTENTION: BOX AFTER FINAL
RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 1714

PATENT

Customer No. 22,852

Attorney Docket No. 01064.0011-04000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Richard LEVY) Group Art Unit: 1714
Serial No.: 09/357,957) Examiner: M. Medley
Filed: July 21, 1999)
For: LUBRICANT COMPOSITIONS)
AND METHODS)

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

SUBMISSION OF MARKED UP VERSION OF AMENDED CLAIMS PURSUANT TO
37 C.F.R. §1.121

Appellant submits the following marked up version of amended claims pursuant to 37 C.F.R. § 1.121 with the 37 C.F.R. § 1.116 amendment filed in response to the new rejection of claims 29, 35 and 42 in the Examiner's Answer of May 22, 2002.

IN THE CLAIMS:

29. (Amended Twice) A lubricating composition of matter consisting essentially of a superabsorbent polymer that absorbs greater than about 100 times its

weight in water combined with a material for decreasing friction between moving surfaces wherein said material for decreasing friction is a petroleum oil [lubricant or] grease [thereof], a solid inorganic compound, a solid organic compound, water containing a lubricant additive, a phosphate, a fatty oil, fatty acid or wax, a synthetic oil lubricant which is selected from silicones, polyphenyl ethers, silicates, chlorinated aromatics, fluorocarbons, and polyglycol lubricants, or [grease] greases thereof, or a soap, and a petroleum oil or an isostearyl alcohol containing two oxyethylene groups, polymerized olefins, or organic esters, wherein said lubricating composition is substantially anhydrous where said material for decreasing friction is a petroleum oil, or an isostearyl alcohol containing two oxyethylene groups, polymerized olefins, or organic esters, and mixtures thereof.

32. (Amended Once) The composition of claim 31 where said solid [organic] inorganic lubricant is molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, mica, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, borax, basic white lead, lead carbonate, lead iodide, asbestos, talc, zinc oxide, carbon, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, or the Group VIII noble metals or mixtures thereof.

42. (Amended Once) The composition of claim 29 where said lubricating composition consists essentially of a superabsorbent polymer combined with a material for decreasing friction between moving surfaces, where said superabsorbent polymer

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absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is [a] said synthetic oil lubricant, or two-mol ethoxylate of isostearyl alcohol, or [grease] greases thereof, and wherein said material for decreasing friction optionally contains a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

REMARKS

If entry of this submission requires an extension of time pursuant to 37 C.F.R. § 1.136 or payment of an extension of time fee or other fee, any of which this submission fails to account for, appellant's attorneys request such an extension and payment of any fees due from their Deposit Account 06-0916.

Respectfully submitted,

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